

Appl. No. : **10/001,736**
Filed : **October 31, 2001**

REMARKS

In response to the Office Action, Applicant respectfully requests the Examiner to reconsider the above-captioned application in view of the foregoing amendments and the following comments.

Discussion of Rejections under §35 U.S.C. §103(a) over Kim (U.S. Patent No. 5,777,680) in view of Breeuwer (U.S. Patent No. 5,917,609)

In the Office Action, the Examiner rejected independent Claims 1-5, 6-8, 11, 12, 16, 19-22, 24-26, 28-31, 33 and 33 as being unpatentable over Kim in view of Breeuwer.

Amended Claim 1 is directed to method of adaptive encoding at least a part of a current frame of a sequence of frames of framed data that includes, among other elements, “performing a second sub-encoding on the first sub-encoded block, the second sub-encoding adapting at least one encoding parameter based upon a characteristic indicative of an energy content of the first sub-encoded part of the current frame, the characteristic being determined by prediction at least in part from of the frames of the sequence only those frames that are a reference frame.” Applicant respectfully submits that similar types of limitations are recited in the other independent claims.

To establish a *prima facie* case of obviousness a three-prong test must be met. First, there must be some suggestion or motivation, either in the references or in the knowledge generally available among those of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success found in the prior art. Third, the prior art reference must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). Applicant respectfully submits that the cited prior art fails to teach or suggest in isolation or in combination at least one limitation from each of the above-listed independent claims.

In the Office Action, it was recognized that Kim fails to describe the second sub-encoding as is claimed. In the Office Action, the Examiner stated that this limitation was taught or suggested by Breeuwer. The Examiner stated:

Breeuwer teaches that prior art computing systems provide low video quality images (Breeuwer: column 1, lines 33-55). To help alleviate this problem, Breeuwer discloses “the second sub-encoding adapting at least one parameter based upon a characteristic indicative of an energy content” (Breeuwer: column 2, line 60 – column 3, line 15, wherein the sub-encoding is performed by the model-based encoder). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the apparatus disclosed by Kim

Appl. No. : **10/001,736**
Filed : **October 31, 2001**

and add the encoding scheme taught by Breeuwer in order to obtain an apparatus that can provide the highest possible video quality. *See* Office Action, p. 3.

Applicant respectfully submits that Breeuwer fails to teach or suggest an encoder as is claimed. Claim 1 recites: “the second sub-encoding adapting at least one encoding parameter based upon characteristic indicative of an energy content of the first sub-encoded part of the current frame, *the characteristic being determined by prediction at least in part from of the frames of the sequence only those frames that are a reference frame.*” Applicant respectfully submits that the italicized limitation is not taught or suggested by the cited references. Applicant respectfully submits that Breeuwer wholly fails that its wave encoder bases its encoding by prediction from only reference frames.

Furthermore, in the Office Action, the Examiner took the position that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the apparatus disclosed by Kim and add the encoding scheme taught by Breeuwer in order to obtain an apparatus that can provide the highest possible video quality.” Applicant submits that this finding does not support a *prima facie* rejection. Applicant submits that the prior art must suggest the desirability of the claimed invention and combination of such features. *See* M.P.E.P. § 2143.01. The fact that references can be modified is not sufficient to establish *prima facie* obviousness. *Id.* Furthermore, the fact that the claimed invention is within the capability of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness. *Id.* In this case, the Examiner has merely made conclusory findings regarding the motivation to modify the Kim system with Breeuwer. Applicant respectfully submits that the Examiner has failed to provide a *prima facie* rejection and that the rejected claims are in condition for allowance.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims. Accordingly, early issuance of a Notice of Allowance is most earnestly solicited.

The undersigned has made a good faith effort to respond to all of the noted rejections and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if an issue requires clarification, the Examiner is respectfully requested to call Applicant’s attorney in order to resolve any such issue promptly.

Appl. No. : **10/001,736**
Filed : **October 31, 2001**

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 3/14/2009

By:


Eric M. Nelson
Registration No. 43,829
Attorney of Record
Customer No. 20,995
(619) 235-8550

2415161
030306